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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/693,469

10/24/2003

Ted J. Reffeti

STD 1141 PA/41213.507

2532

23368 7590 04/03/2007

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EXAMINER

BATTULA, PRADEEP CHOUDARY

ART UNIT

PAPER NUMBER

3722

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/693,469

Applicant(s)

REFFETT, TED J.

Examiner

Pradeep C. Battula

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to the amendment filed on December 26, 2006

Election/Restrictions

Applicant's election was acknowledged in the action mailed October 16, 2006 it was found that Applicant's traversal was lacking and therefore treated as an election without traverse.

The new traversal filed on December 26, 2006 is correnct on the ground(s) that all species include a first ply with a printable region, a second ply with a printable region and adhesive and release layers disposed between facing surfaces of the first and second plies in the manner recited in Claim 1.

Response to Amendment

The affadavit filed on December 26, 2006 under 37 CFR 1.131 is sufficient to overcome the Blank reference.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 1, 4, 6 – 11, 14,15, 18 – 21, 29 – 33, and 35 – 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Buske (U.S. 3,524,782).

In regards to Claim 1, Buske discloses An adhesive form comprising: a first ply 20 comprising a front and a back opposite said front (Figure 9, Item 20), said front

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comprising a first ply first printable region (Column 2, Lines 42 – 43) and a first ply second printable region disposed thereon Column 2, Lines 38 – 50); the following label can be considered another printable region), each of said first ply printable regions separable from said first ply along a respective line of weakness 21 that extends therethrough (Column 2, Lines 51 – 54; Figure 4, Item 21); a second ply 22 comprising a front and a back opposite said front (Figure 9, Item 22), said front of said second ply and said back of said first ply being disposed to face one another such that a substantially stacked relation is defined by said first and second plies (Column 2, Lines 38 – 41), said back of said second ply defining a separable region 25 (Column 2, Lines 41 – 43; Figure 9, Item 25) comprising: a second ply printable region (25; separable region is a printable region) disposed therein, said second ply printable region separable from said second ply along a line of weakness 21 that extends therethrough such that (Column 2, Lines 51 – 54; Each area where the label is separated from other labels (Figure 1 type labels on a sheet) is a line of weakness along with 21 being a line of weakness), when said first and second plies are in said substantially stacked relationship, said second ply printable region is substantially coextensive with said first ply first printable region (Figure 4, Items 24, indicia on 20); and an affixing region adjacent said second ply printable region (Column 2, Lines 54 – 58) with an adhesive layer 23 disposed between at least a portion of said back of said first ply and said front of said second ply such that a bond is formed therebetween (Column 2, Lines 33 – 40); and a release layer disposed between at least a portion of said back of said first ply and said front of said second ply (Column 2, Lines 33 – 37), said release layer and said

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adhesive layer configured to allow selective removal of a first label defined by said separable region (Column 2, Lines 38 – 50) and said first ply first printable region such that, upon said removal of said first label, said adhesive layer disposed on said front of said second ply opposite said affixing region becomes exposed such that said first label can be adhesively affixed to an object (Column 2, Lines 52 – 58), said release layer and said adhesive layer further configured to allow selective removal of a second label defined by said first ply second printable region (Column 2, Lines 33 – 50), said second label including a portion of said adhesive layer that, upon said removal of said second label, becomes exposed such that said second label can subsequently be affixed to an object (Column 2, Lines 52 – 58), wherein said form is configured such that at least said printable regions on each said first and second labels corresponding to said first ply can accept printed indicia thereon from a single pass through an automated simplex printing device (Column 2, Lines 38 – 43).

In regards to Claim 4, as applied to Claim 1, Buske further discloses wherein said form is a cut sheet (Column 2, Lines 38 – 50; Buske).

In regards to Claim 6, as applied to Claim 1, Buske further discloses wherein said first ply second printable region is disposed laterally adjacent said first ply first printable region on said form (The examiner considers two first ply labels to comprise the adhesive form).

In regards to Claim 7, as applied to Claim 1, Buske further discloses wherein said first ply second printable region is disposed longitudinally adjacent said first ply first

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printable region on said form (Examiner considers that more than one cut label can be used in the adhesive form).

In regards to Claims 8 and 9, as applied to Claim 1, Buske further discloses a label with indicia (Figure 1). Buske discloses the claimed invention except for the specific arrangement and/or content of indicia (shipping indicia) set forth in the claim(s). It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of information does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

The examiner asserts that the label comprising instructive indicia is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and unobvious functional relationship between the printed matter (shipping indicia) and the substrate (ply) which is required for patentability.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

In regards to Claim 10, as applied to Claim 8, Buske further discloses wherein said adhesive layer is disposed across a substantial entirety of said front of said second ply that corresponds to said indicia (Column 2, Lines 33 – 40; Figure 9, Item 23; Buske).

In regards to Claim 11, as applied to Claim 10, Buske further discloses wherein said adhesive layer is disposed across a substantial entirety of said back of said first ply corresponding to said second label (Column 2, Lines 33 – 40; Figure 9, Item 23; Buske).

In regards to Claim 14, as applied to Claim 1, Buske further discloses wherein at least one of said lines of weakness comprises a perforated die cut (Column 2, Lines 51 – 54; Buske).

In regards to Claim 15, as applied to Claim 1, Buske further discloses wherein at least one of said lines of weakness is substantially rectangular in shape (Figure 1 Item 21; Buske).

In regards to Claim 18, as applied to Claim 1, Buske further discloses the form comprising pre-printed indicia on a portion of said back of said second ply (Column 2, Lines 38 – 45; pre-printed considered to be prior to cutting and rolling).

In regards to Claims 19 – 21, as applied to Claim 1 (20, 21) and Claim 18 (19), Buske discloses the claimed invention except for the specific arrangement and/or content of indicia (instructional, product, or linking indicia) set forth in the claim(s). It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an

individual with a specific type of information does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

The examiner asserts that the form comprising indicia is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and unobvious functional relationship between the printed matter (instructional, product, or linking indicia) and the substrate (first and second plies) which is required for patentability.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

In regards to Claim 29, Buske discloses a multi-label form (Figure 9; Examiner considers any number of labels having both plies to make up one form) configured such that each label can accept variable simplex printing on at least one surface thereof (Column 2, Lines 38 – 43) and be separately affixed to an object (Column 2, Lines 52 – 58), said form comprising: a first label comprising: a first ply 20 comprising a front and a back opposite said front (Figure 9, Item 20), said front configured to receive variable printed indicia thereon (Column 2, Lines 38 – 43); a first release layer disposed in contact with said back of said first ply (Column 2, Lines 33 – 37; in contact with ply through adhesive); a first ply line of weakness 21 extending through said first ply (Column 2, Lines 51 – 54; Figure 4, Item 21), said first ply line of weakness defining a border in said back of said first ply about which said first release layer is substantially

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disposed, said first ply line of weakness substantially circumscribing a first printable region in said front of said first ply (Figure 1, indicia inside 21); a first adhesive layer 23 in contact with each of said back of said first ply and said first release layer (Column 2, Lines 33 – 40; Figure 9, Items 20, 22, 23); a second ply 22 comprising a front and a back opposite said front (Figure 9, Item 22), said back of said second ply configured to receive printed indicia thereon (Column 2, Lines 41 – 43), said front of said second ply in contact with said first adhesive layer such that a bond between said first and second plies is formed (Column 2, Lines 38 – 41); a second ply line of weakness (made at 29) extending through said second ply, said second ply line of weakness defining a border substantially circumscribing a second ply printable region 25 in said back of said second ply such that an area encompassing at least said second ply printable region and said border is defined (Column 2, Lines 41 – 43; Figure 9, Item 25); and a cut line formed in said second ply to define an edge of said area and to facilitate separation of said first label from said form (same as cut defined at 29; Figure 9, item 25), said cut line and said lines of weakness configured such that upon removal of said first label from said form along said cut line, said bonded plies remain attached to said border formed in said area, while a portion of said first adhesive layer that remains disposed on said second ply opposite said border becomes exposed such that said first label can be adhesively affixed to said object (Column 2, Lines 52 – 58); and a second label disposed adjacent said first label, said second label comprising: a first ply 2- having a front and a back opposite said front (Figure 9, Item 20), said front of said second label configured to receive variable printed indicia thereon (Column 2, Lines 38 – 50); a

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second adhesive layer 23 disposed in contact with said back of said second label first ply (Column 2, Lines 33 – 40; Figure 9, Item 23); a first ply line of weakness 21 extending through said second label first ply and substantially circumscribing a second printable region in said front of said first ply (Column 2, Lines 51 – 54; Figure 4, Item 21; Figure 1, Item indicia); a second release layer disposed in contact with said second adhesive layer (Column 2, Lines 33 – 37; Figure 9, Item 23); and a second ply 22 comprising a front and a back opposite said front (Figure 9, Item 22), said front of said second ply in contact with said second adhesive 23 layer and said second release layer such that a bond between said second label first and second plies is formed (Column 2, Lines 35, 38 – 40; Figure 9, Item 23), said second label configured such that upon removal of said second printable region from the remainder of said first ply, said second adhesive layer present on said back of said second print region can be placed in contact with said object to affix said second label thereto (Column 2, Lines 52 – 58; Figure 1, Figure 2, Figure 7).

In regards to Claim 30, as applied to Claim 29, Buske further discloses wherein said first release layer is patterned (Column 2, Lines 35 – 37; constant pattern).

In regards to Claim 31, as applied to Claim 29, Buske further discloses wherein said first release layer and said second release layer comprise the same constituent materials (Column 2, Lines 35 – 37).

In regards to Claim 32, as applied to Claim 29, Buske further discloses wherein said first adhesive layer and said second adhesive layer comprise the same constituent materials (Column 2, Lines 33 – 35; Figure 9, Item 23).

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In regards to Claim 33, as applied to Claim 29, Buske further discloses wherein said front of said first label is substantially coplanar with said front of said second label (Figure 10).

In regards to Claims 35 and 36, as applied to Claim 29, please review the rejection for Claims 8 and 9.

In regards to Claim 37, Buske discloses a combination packing list and shipping label form (examiner considers one form to constitute multiple labels in assembly) configured to be affixed to an object (Figure 7), said form comprising: a packing list comprising: a packing list first ply 20 comprising a front and a back opposite said front (Figure 9, Item 20); a first line of weakness 21 formed in said front of said packing list first ply such that a first printable region is bounded by said packing list first line of weakness (Column 2, Lines 51 – 54; Figure 1, Item 21), said first printable region configured to accept printed indicia thereon (Column 2, Lines 38 – 50; Figure 1); a patterned release layer facing said back of said packing list first ply (Column 2, Lines 33 – 37); an adhesive layer 23 facing each of said back of said packing list first ply and said patterned release layer (Column 2, Lines 33 – 40; Figure 9, Item 23); a packing list second ply 22 comprising a front and a back opposite said front (Figure 9, Item 22), said packing list second ply facing said adhesive layer (Figure 9, Items 22, 23) such that at least a portion of said front of said second ply is bonded to at least a portion of said back of said first ply to define a multi-ply label (Column 2, Lines 38 – 40); a packing list second line of weakness (created at 29) formed in said back of said packing list second ply such that a second printable region 25 is bounded by said packing list second line of

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weakness (Column 2, Lines 41 – 44; Figure 9, Items 25, 29); and a shipping label contiguous with said packing list, said shipping label comprising: a shipping label first ply comprising 20 a front and a back opposite said front (Figure 9, Item 20), said front configured to receive variable indicia printed thereon (Column 2, Lines 51 – 54); a shipping label line of weakness 21 formed in said front of said shipping label first ply such that a shipping label printable region is bounded by said shipping label line of weakness said shipping label printable region configured to accept printed indicia thereon (Column 2, Lines 51 – 54; Figure 1, Item 21); an adhesive layer 23 facing said back of said shipping label first ply (Column 2, Lines 33 – 40; Figure 9, Item 23); a release layer facing at least a portion of said adhesive layer (Column 2, Lines 35 – 37; Figure 9, Item 22, 23); and a shipping label second ply 22 comprising a front and a back opposite said front (Figure 9, item 22) such that said front of said shipping label second ply faces said release layer (Column 2, Lines 35 – 37).

In regards to Claim 38, as applied to Claim 37, Buske further discloses wherein said packing list second line of weakness 24 (Column 2, Lines 48 – 49) is disposed substantially coextensive with said packing list first line of weakness (Figure 9, Items 21, 24; repeated).

In regards to Claim 39, as applied to Claim 37, Buske further discloses a separable region (boundary lines 21; Figure 2) disposed about said packing list second line of weakness (at contour 24); and a border region disposed about said shipping label line of weakness (boundary line 21 of next label).

In regards to Claim 40, as applied to Claim 39, Buske further discloses wherein said separable region comprises said packing list second printable region and an affixing region adjacent said packing list second printable region (Column 2, Lines 56 – 58; Figure 7; Figure 9, Items 20, 22; Figure 10, Items 20, 22).

In regards to Claim 41, as applied to Claim 37, Buske further discloses whereby said form is configured such that said fronts of said first plies of said shipping label and said packing list are substantially coplanar with one another (Column 2, Lines 38 – 50; Figure 9, all labels co-planar).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buske.

In regards to Claim 2, as applied to Claim 1, Buske further discloses wherein said separable region is at least partially bounded along a cut line 29 that extends depth wise through at least said second ply (Column 2, Lines 43 – 44).

Buske does not disclose the cut is lengthwise substantially from one edge of said second ply to another. However, the fact that the cut is longer lengthwise is not stated as critical by the applicant and furthermore does not create an unexpected result. It only makes the second ply printable region of greater size lengthwise. It would have

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been an obvious matter of design choice to create a longer lengthwise cut because such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

In regards to Claim 5, as applied to Claim 1, it is seen that the ply's are rolled and separated in the prior art but, an omission of an element and its function is obvious if the function of the element is not desired. *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975). In Applicant's case, two rolls are not desired and the user separates the labels from the carrier sheets/plies. Therefore it would have been obvious to remove roll process 33 of Buske because it is held that removing an element is obvious to one with ordinary skill in the art.

3. Claims 3, 12, 13, and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Buske in view of Konkol et al. (Konkol; U.S. 5,735,549).

In regards to Claim 3, as applied to Claim 1, Buske does not disclose wherein said second ply printable region is permanently adhered to said first ply first printable region.

Konkol discloses a dual ply label 10 where spot coating is done in order to allow for a particular section of the two mated plies to be permanently adhered (Column 4, Lines 35 – 36, Lines 54 – 61). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the teachings of Konkol in order to prevent the coupon of Buske from being removed from the first ply.

In regards to Claim 12, as applied to Claim 10, Buske does not disclose wherein said release layer disposed between said first and second plies of said first label is patterned such that it only occupies the portion outside said corresponding line of weakness defined in said first printable region.

Konkol discloses a dual ply label 10 where spot coating is done in order to allow for a particular section of the two mated plies to be permanently adhered (Column 4, Lines 35 – 36, Lines 54 – 61). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the teachings of Konkol in order to prevent the coupon of Buske from being removed from the first ply.

In regards to Claim 13, as applied to Claim 1, Buske does not disclose wherein at least one of said lines of weakness comprises a full die cut.

Konkol discloses a dual ply label 10 where in panels to be removed are die cut (Column 4, Lines 35 – 36; Column 5, Lines 1 – 2). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use die cuts in place of perforations it is a mere substituting of equivalents known for the same purpose of separating components (Column 2, Lines 59 – 61; Buske).

In regards to Claim 16, as applied to Claim 15, Buske discloses wherein said line of weakness 21 corresponding to said first label in said second ply is a perforated die cut (Column 2, Lines 51 – 54) and cuts made at 29 and 30 (Column 2, Lines 43 – 45).

Buske does not disclose wherein said lines of weakness corresponding to said first and second labels in said first ply are full die cuts.

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.Konkol discloses a dual ply label 10 where in panels to be removed are full die cut (Column 4, Lines 35 – 36; Column 5, Lines 1 – 2). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to use full die cuts in order to more smoothly remove labels as shown in Konkol (Figure 5; Konkol).

4. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buske in view of Konkol and Franklin (U.S. 5,255,456).

In regards to Claim 17, as applied to Claim 16, Buske modified by Konkol does not disclose wherein at least one corner defined in said perforated die cut comprises a full die cut to facilitate ease of grasping.

Franklin discloses of a substantially rectangular perforation 6 in a double layer card which has a corner 9 that is die cut in order to allow easy removal without tearing. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention to have a full die cut corner in a perforated line of weakness in order to allow easy removal without tearing (Column 3, Lines 39 – 50; Franklin).

5. Claims 23 – 28 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buske in view of Horton-Steidle et al. (Horton; U.S. 6,167,679).

In regards to Claims 23 and 24, as applied to Claim 1, Buske does not disclose an overlap region defined by stacked relationship between a portion of said first ply and a portion of said second ply such that said first and second labels are not coplanar with one another.

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Horton discloses two bodies 20, 30 with both having two plies (22, 26, 32) of the same material where both bodies have their respective plies connected by adhesive 24, 34 (Column 2, Lines 17 – 21; 35 – 39; Figure 1B, Items 20, 22, 24, 26, 30, 32, 34); wherein the bodies are in stacked relationship where the bodies are not co planar and connected by a adhesive line 12 (Column 2, Lines 12 – 13). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to stack the different labels of Buske because it has been held that rearranging parts of an invention involves only routine skill in the art.

In regards to Claim 25, as applied to Claim 23, Buske modified by Horton does not disclose wherein portions of said second ply and said release layer that both correspond to one of said labels are removed prior to construction of said form such that a cutout defined by said removed portion is substantially coextensive with a corresponding portion of said other label.

With respect to wherein portions of said second ply and said release layer that both correspond to one of said labels are removed prior to construction of said form; it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

Furthermore, Applicant is merely removing all items except for the first ply outside of the label area because the liner, adhesive, and second ply in this area do not effect the use of either label. Omission of an element and its function is obvious if the

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function of the element is not desired. *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

In regards to Claims 26 and 27, as applied to Claim 1, Buske does not disclose an overlap region defined by a stacked relationship between a portion of said first ply and a portion of said second ply such that said first and second labels are substantially coplanar with one another.

Horton discloses two bodies 20, 30 with both having two plies (22, 26, 32) of the same material where both bodies have their respective plies connected by adhesive 24, 34 (Column 2, Lines 17 – 21; 35 – 39; Figure 1B, Items 20, 22, 24, 26, 30, 32, 34); wherein the bodies are in stacked relationship where the bodies are not co planar and connected by a adhesive line 12 (Column 2, Lines 12 – 13). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to stack the different labels of Buske because it has been held that rearranging parts of an invention involves only routine skill in the art.

Furthermore, Buske modified by Horton discloses the claimed invention except for a removal of certain items to make the labels substantially coplanar. Applicant is merely removing all items except for the first ply outside of the label area because the liner, adhesive, and second ply in this area do not effect the use of either label. Omission of an element and its function is obvious if the function of the element is not desired. *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975). Lastly, the modification discloses abutting plies and second plies where the abutting first plies are laterally offset relative to said abutting second plies.

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In regards to Claim 28, as applied to Claim 1, Buske does not disclose wherein said first label comprises a first material and said second label comprises a second material, said second material being different from said first material, said form further comprising an overlap region wherein a portion of said first material adhesively overlaps a portion of said second material, bonding said first material to said second material and forming a seam therebetween.

Horton discloses two bodies 20, 30 with both having two plies (22, 26, 32) of the different material where both bodies have their respective plies connected by adhesive 24, 34 (Column 2, Lines 17 – 21; 35 – 39; Figure 1B, Items 20, 22, 24, 26, 30, 32, 34); wherein the bodies are in stacked relationship where the bodies are not co planar and connected by a adhesive line 12 (Column 2, Lines 12 – 13) forming a seam therebetween. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to stack the different labels of Buske because it has been held that rearranging parts of an invention involves only routine skill in the art.

In regards to Claim 34, as applied to Claim 33, Buske does not disclose an overlap region between said first label and said second label such that a portion of said form that corresponds to one of said labels adhesively overlaps a portion that corresponds to the other of said labels.

Horton discloses two bodies 20, 30 with both having two plies (22, 26, 32) of the same material where both bodies have their respective plies connected by adhesive 24, 34 (Column 2, Lines 17 – 21; 35 – 39; Figure 1B, Items 20, 22, 24, 26, 30, 32, 34);

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wherein the bodies are in stacked relationship where the bodies are not co planar and connected by a adhesive line 12 (Column 2, Lines 12 – 13). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to stack the different labels of Buske because it has been held that rearranging parts of an invention involves only routine skill in the art.

Response to Arguments

Applicant's arguments with respect to claims 1 – 41 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pradeep C. Battula whose telephone number is 571-272-2142. The examiner can normally be reached on Monday - Thursday 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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PCB
Patent Examiner
March 13, 2007

~~MONICA S. CARTER
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